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EXAMINER

HUNTSINGER, PETER K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,490	Applicant(s) WINTER ET AL.	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-129 is/are pending in the application.
- 4a) Of the above claim(s) 38,42,66,67,94,96-112,115,116,118-122 and 128 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37,39-41,43-65,68-93,95,113,114,117,123-127 and 129 is/are rejected.
- 7) ☐ Claim(s) 71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I in the reply filed on 4/6/07 is acknowledged. The traversal is on the ground(s) that the species are not mutually exclusive. This is not found persuasive because Species I contains limitations not present in Species II and Species II contains limitations not present in Species I. These limitations, such as image cropping in Species I and Album design in Species II are not obvious variations.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 21, 47, 85, 113, and 125 are designated as generic.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 77 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 77 includes the limitation "each graphical representation indicative of the effect of the enhancement" wherein the graphical representation is on the form that according to claim 74 includes the user designation areas indicative of a particular image

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enhancement. It is not possible for the user to mark the form for a particular enhancement and that same form to include the results of that enhancement. The results of the enhancement would have to appear on a different form than the form designating those enhancements.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 44 and 114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 44 recites the limitation "the system" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 114 and 117 recite the limitation "the operations" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 123 and 124 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The examiner suggests amending the claim to state "A computer-readable medium storing a program."

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 21-24, 26-37, 39, 41, 43-58, 64, 65, 68-70, 72, 73, 113, 114, 123-126, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks '387, and further in view of well known prior art.

Referring to claim 21, Hicks '387 discloses a printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising: a print mechanism (printer mechanism, col. 3, lines 37-45) configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas (Fig. 2). Hicks '387 also discloses a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); and program logic configured to cause a print mechanism to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas (col. 4, lines 27-35, producing photographic prints). Hicks '387 does not disclose expressly the printer with

a scanner mechanism and the printer generating the final print sheet. Official Notice is taken that it is well known and obvious for a printer to include a scanner and to print photos. The motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 21.

Referring to claim 22, Hicks '387 discloses the scanning the form with the scanning mechanism but does not disclose expressly inserting the form into an input/output tray of the printer. Official Notice is taken that it is well known and obvious to reinsert a form in an input/output tray of a printer. The motivation for doing so would have been to utilize a convenient method for the user to transport the document to the scanner. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 22.

Referring to claim 23, Hicks '387 discloses a data transfer interface configurable to receive the digitally stored images, but does not disclose expressly the interface being a memory card reader or an I/O port. Official Notice is taken that it is well known and obvious for a printer to have a memory card reader or an I/O port. The motivation for doing so would have been to receive images from a camera or from a computer. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 23.

Referring to claim 24, Hicks '387 discloses a printer, but does not disclose expressly graphics of microscopic pixels. Official Notice is taken that it is well known

and obvious to print photos with microscopic pixels. The motivation for doing so would have been to print high quality photos. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 24.

Referring to claim 26, Hicks '387 discloses wherein the graphical representations of the selected ones of the plurality of images include thumbnail images (Fig. 2, images considered thumbnails because they are smaller versions of larger images).

Referring to claim 27, Hicks '387 discloses wherein one of the user designation areas is located on the combination proof sheet and order form adjacent to and is associated with a corresponding one of the thumbnail images (order form 26 of Fig. 2, col. 3, lines 29-36).

Referring to claim 28, Hicks '387 discloses wherein the user designation areas to be user-completed include locations markable by the user with a marking implement (col. 3, lines 58-62).

Referring to claim 29, Hicks '387 discloses markable locations but does not disclose expressly bubble-shaped regions. Official Notice is taken that it is well known and obvious to utilize bubble-shaped regions. The motivation for doing so would have been to utilize regions easy to mark with pen or pencil. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 29.

Referring to claim 30, Hicks '387 discloses wherein at least some of the markable locations comprise at least one of vertical slots between adjacent vertical bars and discrete bounded regions (Fig. 2, order form 26 shows discrete bounded regions).

Referring to claim 31, Hicks '387 discloses wherein the combination proof sheet and order form includes user readable printed indicia (Fig. 2).

Referring to claim 32, Hicks '387 discloses wherein the scanner mechanism is an optical scanner (col. 4, lines 16-26, passing the combined print and order form through a suitable read device).

Referring to claim 33, Hicks '387 discloses an optical scanner mechanism but does not disclose expressly wherein the optical scanner is selected from a group consisting of a photo detector array, a paper edge sensor, a media type sensor, and an ink jet pen activation energy sensor. Official Notice is taken that it is well known and obvious to utilize a photo detector array, a paper edge sensor, a media type sensor, or an ink jet pen activation energy sensor. The motivation for doing so would have been to utilize a scanning mechanism best served for the medium that is scanned. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 33.

Referring to claim 34, Hicks '387 discloses a scanner mechanism but does not disclose expressly wherein the scanner mechanism is selected from a group consisting of an electrical scanner and a mechanical scanner. Official Notice is taken that it is well known and obvious to utilize an electrical scanner or a mechanical scanner. The motivation for doing so would have been to utilize a widely available type of scanner.

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Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 34.

Referring to claim 35, Hicks '387 discloses wherein a particular one of the user designation areas is associated with a corresponding one of the digitally stored images (col. 3, lines 9-20).

Referring to claim 36, Hicks '387 discloses wherein the particular one of the user designation areas is adjacent the graphical representation of the corresponding one of the digitally stored images (order form 26 of Fig. 2, col. 3, lines 29-36).

Referring to claim 37, Hicks '387 discloses wherein a particular one of the user designation areas is associated with a corresponding plurality of the digitally stored images (order form 26 of Fig. 2, col. 3, lines 29-36).

Referring to claim 39, Hicks '387 discloses the digitally stored images but does not disclose expressly how the images are transferred to the printer. Official Notice is taken that it is well known and obvious to utilize a direct data link to receive images in a printer. The motivation for doing so would have been to connect a computer to the printer directly to accommodate printing computer files. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 39.

Referring to claim 41, Hicks '387 discloses a memory configured to store the digitally stored images (printer mechanism, col. 3, lines 37-45). It is inherent that the printer has a page memory to print the proof and order sheet.

Referring to claim 43, Hicks '387 discloses a printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, the printer comprising: a print mechanism (printer mechanism, col. 3, lines 37-45) capable of generating graphical representations of selected ones of the plurality of images and a plurality of user designation areas on a print medium (Fig. 2). Hicks '387 also discloses a scanner mechanism capable of detecting at least one user designation area on the print medium after it has been completed by a user (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); program logic configured to cause the print mechanism to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas (Fig. 2); program logic configured to cause the scanner mechanism to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner mechanism (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner mechanism; and program logic configured to cause a print mechanism to generate at least one final print sheet having a graphical representation in accordance with the user designation areas completed by the user (col. 4, lines 27-35, producing photographic prints). Hicks '387 does not disclose expressly the printer with a scanner mechanism and the printer generating the final print sheet. Official Notice is taken that it is well known and obvious for a printer to include a scanner and to

print photos. The motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 43.

Referring to claim 44, Hicks '387 discloses a data transfer interface configurable to receive the plurality of digitally stored images (col. 3, lines 37-45). It is inherent that the printer has data transfer interface to receive the images from the computer.

Referring to claim 45, see the rejection of claim 43 above.

Referring to claim 46, see the rejection of claim 21 above.

Referring to claim 47, Hicks '387 discloses a method for selecting and printing digitally stored images available to a printer, comprising: generating with the printer (printer mechanism, col. 3, lines 37-45) a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas (Fig. 2); scanning the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); detecting and interpreting the completed user designation areas; and printing, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas (col. 4, lines 27-35, producing photographic prints). Hicks '387 does not disclose expressly scanning with the printer and automatically printing. Official Notice is taken that it is well known and obvious for a printer to include a scanner and to print automatically. Further,

it is common for copiers print automatic after a document is scanned. The motivation for doing so would have been to combine the functions of a scanner with those of a printer and to eliminate user interaction for printing photos. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 47.

Referring to claim 48, Hicks '387 discloses automatically detecting a re-insertion of the user-completed combination proof sheet and order form; and initiating the detecting and interpreting in response thereto (col. 4, lines 16-26, passing the combined print and order form through a suitable read device).

Referring to claim 49, Hicks '387 discloses wherein the plurality of user designation areas includes at least one of an image selection user designation area and an image enhancement user designation area (col. 3-4, lines 58-68, 1-6, whether user marks package determines image selection).

Referring to claim 50, Hicks '387 discloses generating an identity marker on the combination proof sheet and order form, the identity marker uniquely associated with at least one of the graphically represented images (Group code and frame number 28 of Fig. 2, col. 3, lines 37-45); and scanning the identity marker using the printer so as to confirm that the at least one, of the graphically represented images is available to the printer, before printing the at least one final print (col. 4, lines 16-35) The group and frame number must be obtained for printing the photos and thus confirms that the image is available, otherwise printing would not be possible.

Referring to claim 51, Hicks '387 discloses wherein the scanning the identity marker comprises: comparing the identity marker to a code associated with the at least one of the graphically represented images (Group code and frame number 28 of Fig. 2, col. 3, lines 37-45). It is inherent that the group and frame number on the order sheet correspond to the group and frame number in the computer database.

Referring to claim 52, Hicks '387 discloses preventing the printing if the at least one of the graphically represented images is unavailable to the printer. It is inherent that the printer cannot print if there is no image data.

Referring to claim 53, Hicks '387 discloses the identity marker, but does not disclose expressly wherein the identity marker comprises a pattern of printed and unprinted locations. Official Notice is taken that it is well known and obvious for an identity marker to include printed and unprinted locations. Further, a barcode is widely used and an example of an identity marker with printed and unprinted locations. The motivation for doing so would have been to utilize a marker that is easily scanned. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 53.

Referring to claim 54, see the rejection of claim 26 above.

Referring to claim 55, see the rejection of claim 28 above.

Referring to claim 56, see the rejection of claim 32 above.

Referring to claim 57, see the rejection of claim 28 above.

Referring to claim 58, Hicks '387 discloses the user designation areas, but does not disclose expressly wherein the user designation areas comprise regions

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markable by a user by a process selected from the group consisting of punching out holes therein, applying a sticker thereto, and applying a conductive marker thereto. Official Notice is taken that it is well known and obvious for to mark a document by punching out holes, applying a sticker, or applying a conductive marker thereto. The motivation for doing so would have been to utilize a method of marking a document that is convenient for the user. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 58.

Referring to claim 64, Hicks '387 discloses wherein a particular one of the user designation areas is markable for specifying at least one of an image selection, an image cropping, an image brightness, an image rotation, a color balance, a superimposed picture date, a print size, a print quantity, and a picture storage selection (col. 3-4, lines 58-68, 1-6, whether user marks package determines image selection).

Referring to claim 65, see the rejection of claim 35 above.

Referring to claim 68, see the rejection of claim 41 above.

Referring to claim 69, Hicks '387 discloses storing at least one of the digitally stored images in a computer connected to the printer (col. 3, lines 8-20).

Referring to claim 70, Hicks '387 discloses wherein the detecting and interpreting comprises: identifying the at least one of the digitally stored images from the completed user designation areas (Fig. 2, col. 3, lines 29-36).

Referring to claim 72, see the rejection of claim 47 above.

Referring to claim 73, see the rejection of claim 47 above.

Referring to claim 113, Hicks '387 discloses at least one processor-readable medium having processor-executable instructions therein which, when executed by a processor, cause the processor to perform operations comprising: controlling a print mechanism (printer mechanism, col. 3, lines 37-45) to generate a combination proof sheet and order form having graphical representations of a plurality of digitally stored images [accessible by the processor] and a plurality of user designation areas (Fig. 2). Hicks '387 also discloses controlling a scanner mechanism to scan the combination proof sheet and order form after completion by a user (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); detecting on the scanned proof sheet and order form at least one user-completed one of the user designation areas; and interpreting the at least one user-completed one of the user designation areas to identify at least one user-selected one of the images and at least one user-selected print characteristic associated with the at least one user-selected one of the images (col. 4, lines 27-35, producing photographic prints). Hicks '387 does not disclose expressly the printer with a scanner mechanism and the printer generating the final print sheet. Official Notice is taken that it is well known and obvious for a printer to include a scanner and to print photos. The motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer. Therefore it would have been obvious to combine well known prior art with Hicks '387 to obtain the invention as specified in claim 21.

Referring to claim 114, Hicks '387 discloses the operations further comprising: controlling the print mechanism to generate at least one final print of the at least one

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user-selected one of the images in accordance with the at least one user-selected print characteristic images (col. 4, lines 27-35, producing photographic prints).

Referring to claim 123, see the rejection of claim 43 above.

Referring to claim 124, Hicks '387 discloses code that interprets the at least one user-completed one of the user designation areas to identify at least one user-selected print characteristic (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); and code that controls the print mechanism to generate the at least one final print in accordance with the at least one user-selected print characteristic (col. 4, lines 27-35, producing photographic prints).

Referring to claim 125, see the rejection of claim 21 above.

Referring to claim 126, Hicks '387 discloses means for generating at least one final print of the at least one user-selected one of the images in accordance with the at least one user-selected print characteristic (col. 4, lines 27-35, producing photographic prints).

Referring to claim 129, see the rejection of claim 21 above.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks '387 and well known prior art as applied to claim 21 above, and further in view of Hall '131.

Referring to claim 25, Hicks '387 discloses a print mechanism, but does not disclose wherein the print mechanism is selected from the group consisting of a laser print mechanism, an ink jet print mechanism, a dot matrix print mechanism, a dye

sublimation print mechanism, and a thermal print mechanism. Hall '131 discloses a laser print mechanism, an ink jet print mechanism, a dot matrix print mechanism, a dye sublimation print mechanism, and a thermal print mechanism (col. 1, lines 34-39). At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a laser, ink, dot matrix, dye sublimation, or thermal print mechanism. The motivation for doing so would have been to utilize a print mechanism best served for the type of printing needed. Therefore, it would have been obvious to combine Hall '131 with Hicks '387 to obtain the invention as specified in claim 25.

12. Claims 40, 59-62, 74-77, 79-93, 95, 117, and 127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks '387 and well known prior art as applied to claims 21, 47, 113, and 125 above, and further in view of Bartz '807.

Referring to claim 40, Hicks '387 discloses wherein the print mechanism is further configurable by stored program logic to generate a custom proof sheet and order form having at least one graphically represented image (order form 26 of Fig. 2, col. 3, lines 29-36). Hicks '387 does not disclose expressly user designation cropping areas. Bartz '807 discloses a custom proof sheet and order form having at least one graphically represented image and user designation cropping areas along adjacent side edges of the image, the user designation cropping areas markable by the user to indicate cropping of the image (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15). At the time of the invention, it would have obvious to a person of ordinary skill in the art to include user designation cropping areas on the proof sheet and order form of Hicks

'387. The motivation for doing so would have been to allow the user to crop ordered prints. Therefore, it would have been obvious to combine Bartz '807 with Hicks '387 to obtain the invention as specified in claim 40.

Referring to claim 59, Bartz '807 discloses generating with the printer at least one custom proof sheet and order form with user designation areas for enhancing a user-selected image (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15).

Referring to claim 60, Bartz '807 discloses wherein the enhancing the user-selected image includes cropping the user-selected image (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15).

Referring to claim 61, Hicks '387 discloses wherein a particular one of the user designation areas is associated with a corresponding one of the digitally stored images (col. 3, lines 9-20).

Referring to claim 62, Hicks '387 discloses wherein the particular one of the user designation areas is adjacent the graphical representation of the corresponding one of the digitally stored images (order form 26 of Fig. 2, col. 3, lines 29-36).

Referring to claim 74, Hicks '387 discloses a method for printing a digitally stored image available to a printer, comprising: generating with the printer a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations (Fig. 2, col. 3, lines 28-37); scanning the form after a user has completed at least one of the user designation areas (col. 4, lines 16-26, passing the combined print and order form through a suitable read device); detecting and interpreting the completed user

designation areas; and printing, responsive to the detecting and interpreting, the digitally stored image with the printer in accordance with the completed user designation areas (col. 4, lines 27-35, producing photographic prints). Hicks '387 does not disclose expressly scanning with the printer and automatically printing. Official Notice is taken that it is well known and obvious for a printer to include a scanner and to print automatically. Further, it is common for copiers print automatic after a document is scanned. The motivation for doing so would have been to combine the functions of a scanner with those of a printer and to eliminate user interaction for printing photos. Hicks '387 does not disclose expressly a user designation area associated with image enhancement. Bartz '807 discloses a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15). At the time of the invention, it would have obvious to a person of ordinary skill in the art to include user designation enhancing areas on the proof sheet and order form of Hicks '387. The motivation for doing so would have been to allow the user to crop and choose the color of ordered prints. Therefore, it would have been obvious to combine Bartz '807 and well known prior art with Hicks '387 to obtain the invention as specified in claim 74.

Referring to claim 75, Hicks '387 discloses automatically detecting a re-insertion into the printer of the user-completed form; and initiating the detecting and interpreting in response thereto (col. 4, lines 16-26, passing the combined print and order form through a suitable read device).

Referring to claim 76, Hicks '387 discloses printing at least one final print of the digitally stored image (col. 4, lines 27-35, producing photographic prints). Bartz '807 discloses enhancing the digitally stored image (col. 3, lines 12-15).

Referring to claim 77, Hicks '387 discloses wherein the form has a plurality of graphical representations of the digitally stored image and at least one user designation area associated with each graphical representation (Fig. 2). Bartz '807 discloses each graphical representation indicative of the effect of the enhancement (col. 3, lines 12-15).

Referring to claim 79, Hicks '387 discloses wherein the form has a single graphical representation of the digitally stored image and a set of user designation areas associated with the graphical representation (Fig. 2). Bartz '807 discloses wherein the completed ones of the set of user designation areas collectively define the enhancement (col. 3, lines 12-15).

Referring to claim 80, Bartz '807 discloses wherein the enhancement is an image cropping selection (col. 3, lines 12-15).

Referring to claim 81, Hicks '387 discloses wherein the set of user designation areas comprises: a horizontal subset of user designation areas adjacent a horizontal edge of the graphical representation (Fig. 2). Hicks '387 does not disclose expressly a vertical subset of user designation areas. Bartz '807 disclose a vertical subset of user designation areas adjacent a vertical edge of the graphical representation (Fig. 1). At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a vertical set of user designation areas. The motivation for doing so would have been to place additional photo options for ordering prints. Therefore, it would have

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been obvious to combine Bartz '807 with Hicks '387 to obtain the invention as specified in claim 81.

Referring to claim 82, Hicks '387 discloses wherein the image cropping selection is defined by the completion of two user designation areas in the vertical subset denoting a first cropping dimension and two user designation areas in the horizontal subset denoting a second cropping dimension (Fig. 1, col. 2-3, lines 67-68, 1-20). Bartz '807 discloses that mark box location is arbitrary.

Referring to claim 83, Bartz '807 discloses wherein the digitally stored image has a print size and cropping the image but does not disclose expressly wherein first and second cropping dimensions are adjusted to best-fit the image to a print size. Official Notice is taken that it is well known and obvious to best-fit an image that has been cropped. The motivation for doing so would have been to conform an image to available medium sizes. Therefore it would have been obvious to combine well known prior art with Hicks '387 and Bartz '807 to obtain the invention as specified in claim 83.

Referring to claim 84, Bartz '807 discloses wherein a digitally stored image has a print size, and wherein the print size is enlarged based on the first and second cropping dimensions (Fig. 1, col. 2-3, lines 67-68, 1-20, size and cropping dimensions are both included in Fig. 1 and selecting both options would enlarge a cropped image).

Referring to claim 85, see the rejection of claim 74 above.

Referring to claim 86, Hicks '387 discloses program logic configured to cause the print mechanism to generate at least one final print having a graphical representation of the image in accordance with the completed user designation areas (col. 4, lines 27-35,

producing photographic prints). Bartz '807 discloses enhancing the image in accordance with the completed user designation areas (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15).

Referring to claim 87 see the rejection of claim 23 above.

Referring to claim 88, see the rejection of claim 24 above.

Referring to claim 89, see the rejection of claim 26 above.

Referring to claim 90, see the rejection of claim 29 above.

Referring to claim 91, see the rejection of claim 31 above.

Referring to claim 92, see the rejection of claim 33 above.

Referring to claim 93, see the rejection of claim 35 above.

Referring to claim 95, see the rejection of claim 41 above.

Referring to claim 117, Hicks '387 discloses the user-selected print characteristic but does not disclose expressly a user designation area associated with image enhancement. Bartz '807 discloses enhancing at least one user-selected one of the images in accordance with at least one user-selected print characteristic (mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15). At the time of the invention, it would have obvious to a person of ordinary skill in the art to include user designation enhancing areas on the proof sheet and order form of Hicks '387. The motivation for doing so would have been to allow the user to crop and choose the color of ordered prints. Therefore, it would have been obvious to combine Bartz '807 and well known prior art with Hicks '387 to obtain the invention as specified in claim 117.

Referring to claim 127, see the rejection of claim 117 above.

13. Claim 63 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks '387, well known prior art, and Bartz '807 as applied to claims 47 above, and further in view of Slater '481.

Referring to claim 63, Hicks '387 discloses user designation areas but does not disclose expressly one user designation area associated with a plurality of images. Slater '481 discloses wherein a particular one of user designation areas is associated with a corresponding plurality of digitally stored images (Fig. 2, col. 4, lines 1-17). At the time of the invention, it would have obvious to a person of ordinary skill in the art to associate a user designation area with a plurality of images. The motivation for doing so would have been to allow the user to mark one area for all photos as opposed to one area for each photo. Therefore, it would have been obvious to combine Slater '481 with Bartz '807 and Hicks '387 to obtain the invention as specified in claim 63.

14. Claims 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks '387, well known prior art, and Bartz '807 as applied to claim 77 above, and further in view of Kobayashi '391.

Referring to claim 78, Bartz '807 discloses the image enhancement but does not disclose expressly brightness selection or color balance selection. Kobayashi '391 discloses wherein an enhancement is selected from the group consisting of a brightness selection and a color balance selection (Fig. 20B). At the time of the invention, it would have obvious to a person of ordinary skill in the art to provide a brightness selection

enhancement. The motivation for doing so would have been to allow the user to select an desired brightness in ordering prints. Therefore, it would have been obvious to combine Kobayashi '391 with Hicks '387 and Bartz '807 to obtain the invention as specified in claim 78.

Allowable Subject Matter

15. Claim 71 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

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PKH



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4/30/07